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EXAMINER

LOVERING, RICHARD D

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 05/09/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,229

Applicant(s)

DAHANAYAKE ET AL.

Examiner

LOVERING

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on MARCH 3, 2003 (EX. 3 MOS; AND T. TERMINAL DISCLAIMER AND 132 DECLARATION).
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.**

Disposition of Claims

- ☒ Claim(s) 1-99 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-53, 55-84, 86-93 AND 95-99 is/are rejected.
- ☒ Claim(s) 54, 85 AND 94 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-6, 10-20, 25, 27, 90-93 and 95-99 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kersnar et al. 4,122,043, esp. Examples 4 and 6. While Kersnar et al. may not state that their aqueous detergent compositions containing amidobetaines are viscoelastic, the compositions of Kersnar et al. would be inherently viscoelastic because they contain the same zwitterionic or amphoteric surfactants and organic or inorganic acids or their salts at the same concentration as those recited in applicants' claims.

3. Claims 21-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kersnar et al. above. The especially pertinent portions of Kersnar are pointed out in the preceding paragraph. While the above stated Examples of Kersnar may not use amidobetaines in which R_3 and R_4 (corresponding to applicants' R_2 and R_3) are both beta-hydroxyethyl or methyl, Kersnar et al. (column 2, line 60 - column 3, line 35) suggest the interchangeability of such amidobetaines with those of their Examples 4 and 6, thus rendering their substitution prima facie obvious.

4. Claims 7-9, 28, 30-48, 53, 55-79, 84 and 86-89 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kersnar et al. above in view of Rubin et al. 4,375,421. Kersnar

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applies as in paragraph 2 above. While the aqueous detergent compositions of Examples 4 and 6 of Kersnar et al. may not contain an anionic surfactant at 1.2% or less by weight, it would have been obvious to one skilled in the art at the time applicants' invention was made to incorporate an anionic surfactant at a concentration of 0.25% by weight into the aqueous detergent compositions of Examples 4 or 6 of Kersnar et al. to obtain an increased thickening thereof in view of the teachings of Rubin et al. (column 9, lines 10-20), noting that their aqueous compositions also contain alkyl-or alkenyl-amidobetaines.

5. Claims 49-52 and 80-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kersnar et al. as applied to claims 21-24 above, and further in view of Rubin et al. above. While the above-modified aqueous detergent compositions of Examples 4 and 6 of Kersnar et al. may not contain an anionic surfactant at 1.2% or less by weight, it would have been obvious to one skilled in the art at the time applicants' invention was made to incorporate an anionic surfactant at a concentration of 0.25% by weight into the above-modified aqueous detergent compositions of Examples 4 and 6 of Kersnar et al. to obtain an increased thickening thereof in view of the teachings of Rubin et al. (loc cit), noting that their aqueous compositions also contain alkyl-or alkenyl-amidobetaines.

6. Claim 29 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The expression "the zwitterionic surfactant being present at 89% or more by weight of the fluid" lacks antecedent basis and support in the specification and in the parent case of this continuation application, and is considered new matter.

7. Claim 31 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claim 31 is indefinite and confusing in reciting "and" between ingredients (2) and (3), instead of between ingredients (3) and (4).

8. Applicants' arguments filed March 3, 2003 have been fully considered but they are not deemed to be persuasive. Applicants' contention that solution 3 of Example 4 is non-viscoelastic because the salt (esp. EDTA) concentration is too high is erroneous, because it is inconsistent with the specification page 11, lines 19-25, which allow salt concentrations as high as 20% by weight. Applicants' assertion that the surfactants of Kersnar et al. are not amphoteric is also

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erroneous, because as taught by Rubin et al. above (column 12, line 57) the cocoamido betaines are amphoteric surfactants. As to claims 49-52 and 80-83 herein, the same comments made by the Examiner in paragraph 3 above are applicable. As to claim 29 herein, the zwitterionic surfactant is present in a concentration of 4% by weight in Examples 7 and 8 herein, not 89% or 92%.

9. The Dahanayake Declaration under 37 CFR 1.132 filed March 3, 2003 is insufficient to overcome the rejection of claims 1-25, 27, 28, 30-53, 55-84, 86-93 and 95-99 based upon Kersnar et al., alone or in view of Rubin et al. above as set forth in the last Office action because: Said Declaration consists essentially of opinions and/or conclusions rather than facts and is inconsistent with the specification at page 11, lines 19-25 in alleging that the salt (esp. an EDTA) concentration of solution 3 of Example 4 of Kersnar et al. is too high for said solution to be viscoelastic. Declarant should have tested the above-mentioned solution 3 and attempted to present factual evidence. Further, Declarant here is a co-inventor rather than a disinterested party. Finally, the Declaration is not signed.

10. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-6, 10-27, 90⁹93 and 95-99 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,482,866. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap the stated claims of the '866 patent. The instant claims in "comprising" do not exclude the particulate proppant or other additive in the claims of the '866 patent.

12. Claims 54, 85 and 94 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claim 29 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

14. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record

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doesn't disclose or fairly suggest the viscoelastic fluids of claims 29, 54, 85 and 94 herein.

15. The disclosure is objected to because of the following informalities: In the specification, page 3, line 20, "FIGURES" should be changed to --DRAWINGS--.

Appropriate correction is required.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cdc
May 8, 2003

Richard D. Lovering
RICHARD D. LOVERING
PRIMARY EXAMINER
GROUP ~~1200~~ 1700